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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,065	02/09/2006	Martin Guels	101643.55963US	4756

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EXAMINER

SELF, SHELLEY M

ART UNIT	PAPER NUMBER
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3725

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/527,065

Applicant(s)

GUELS, MARTIN

Examiner

Shelley Self

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed on January 19, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the prior art reference.

Specification

The amendment(s) to the specification have been approved and entered.

Drawings

The drawings were received on January 19, 2007. These drawings are approved and entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 12-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 18 and as noted in the previous Office Action (9/19/06) regarding claim 12, the word "means" is preceded by the word(s) "fastening" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to

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determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). It is unclear whether or not Applicant is invoking 35 U.S.C. 6th paragraph. Examiner suggests, --means for direct fastening---.

Additionally regarding claims 12 and 18, it is unclear if the "*direct fastening means*" is the same as the means for detachable mounting or if these are two separate limitations/elements. Clarification is required to facilitate a clear understanding of the claimed invention.

Further regarding claims 12, 18 and 19, it is unclear what is meant by "*their respective mounting faces*", i.e. mounting face of the holder body? Mounting face of a knife? With regard to claims 12 and 18, Examiner notes no knife (chipping or slabbing) has been positively recited therefore there is no antecedent basis for the mounting face of a knife. Likewise, it is unclear what is meant by "both mounting faces" What are both mounting faces? Furthermore it is not clear if the mounting faces are the same as the knife contact faces. Also regarding claims 12, 18 and 19 the recitation, "their" renders the claim indefinite, i.e. what does their refer too? The knife, the holder or both the knife and the holder? Examiner suggests clear and positive recitation with proper antecedent basis of all critical interrelationships between the elements.

Further regarding claim 18, the recitation, "*a knife cutting edge*" (line 20) is unclear is this knife cutting edge an edge of either the chipping knife or slabbing knife? Again Examiner notes no positive recitation of any knife within the claim. Reference is only made to the knives (chipping/slabbing) in an intended use function.

With regard to claims 20 and 21, there is insufficient antecedent basis for the recitation, "*the first knife holders*".

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Also regarding claim 20, the claim states, "*a plurality of second knife holders...behind the first knife holders*", Examiner notes the parent claim 19, from which claim 20 directly depends positively recites, a plurality of knife holders, are the first and second knife holders different from "the plurality" recited in claim 19? If so, how, and how do the holders cooperate? Clarification is required.

Regarding claim 21, the circumferential direction of what?

Regarding claim 22, no structure has been defined to be rotating therefore, there is insufficient antecedent basis for the recitation, "*the direction of rotation*". Correction required.

Examiner notes the above listing of 35 U.S.C. 112 rejections is not conclusive, Applicant is required to review all claims for clarity, definiteness, clear recitation of critical cooperation between elements and antecedent basis concerns.

Claim Rejections - 35 USC § 102

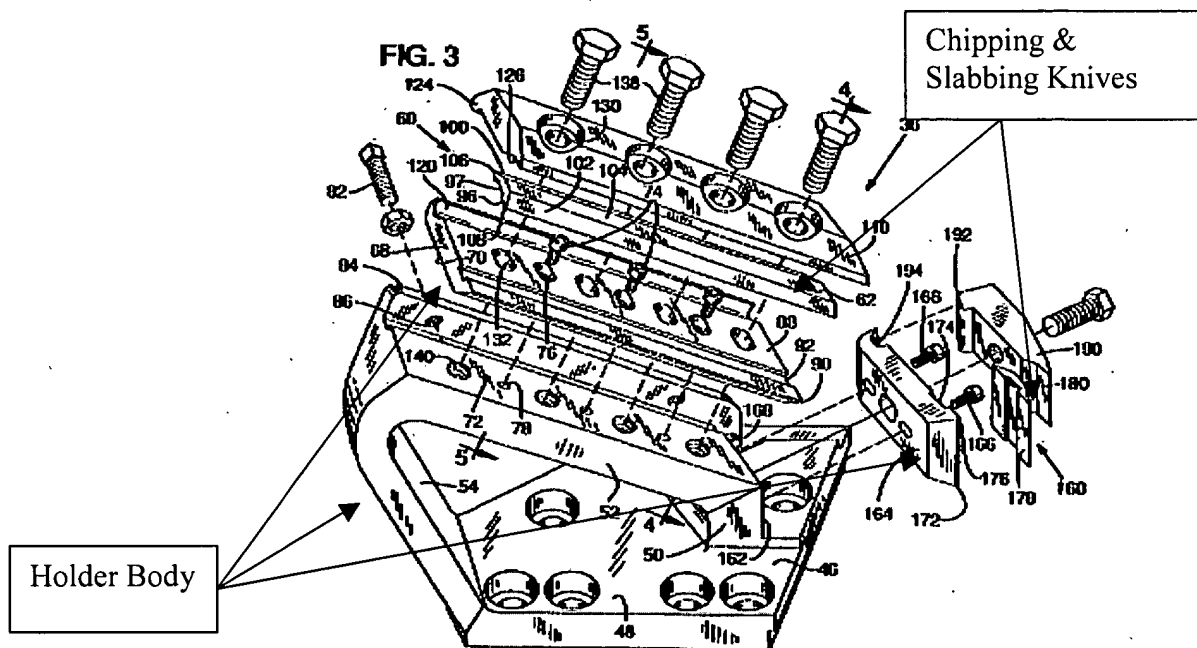
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

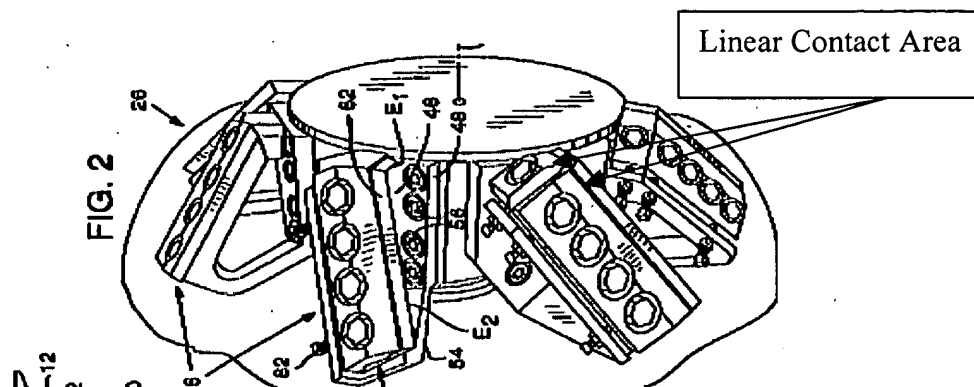
Claim 12, 14, 17, 18-20, 22 and 23 as best as can be understood are rejected under 35 U.S.C. 102(b) as being anticipated by Carpenter et al. (5,271,442). With regard to claims 12, 18, 19, 22 and 23, Carpenter discloses a tool head having a truncated cone shape, knife holder comprising a holder body (46, 68, 164: Examiner notes the claimed invention does not define the

holder to be integral or one-piece), means for detachable mounting of a chipping and slabbing knives (60, 160), mounting faces of the holders (68, 164) having a V-shape.



With regard to claim 14, as best as can be understood, Carpenter discloses screws (fig. 2).

With regard to claim 17, as best as can be understood, Carpenter discloses wherein holder fastening means are provided laterally next to the knife mounting faces of the knife holder for attaching the knife holder on the knife tool head.



With regard to claim 20 as best as can be understood, Carpenter discloses a plurality of knife holders.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13, 15 and 16 as best as can be understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Carpenter et al. (5,271,442) alone or in view of Shantie et al. (5,511,597). Carpenter does not disclose the holder being one-piece. It would have been obvious to the skilled artisan at the time of the invention to construct Carpenter's holder as a one-piece construction because constructing that which was formerly constructed in two/multiple pieces and put together as one integral piece involves only routine skill in the art. See *Howard v. Detroit Stove Works*, 150 U.S. 164.

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Moreover, Shantie teaches in a closely related art, a tool head having a one-piece tool holder (fig. 3), a knife attached to the holder and the holder adhered to the tool head. Shantie teaches this construction so as to minimize separate parts. Because the references are from a closely related art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Carpenter's multi-piece holder with a holder of one-piece construction for improved efficiency as taught by Shantie.

With regard to claims 15 and 16, Carpenter does not explicitly disclose an angle formed by cutting edge of the chipping knife and slabbing knife between 130° and 230° or 80° and 180° . The specific selection or determination of the angle between the chipping knife and the slabbing knife is the result of routine experimentation and would have been obvious at the time of the invention one having ordinary skill in the art to construct Carpenter having angles between 130° and 230° or 80° and 180° because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

Applicant's remarks filed January 19, 2007 are moot in view of the new grounds of rejection noted above.

Conclusion


This Office Action is made non-Final due to the new grounds of rejection noted above.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


SHELLEY M. SELF
PRIMARY EXAMINER

April 10, 2007

A circular black ink stamp from the Office of Intellectual Property (OIPE). The text "OIPE" is at the top, "JAN 19 2007" is in the center, and "PATENT & TRADEMARK OFFICE" is at the bottom. The number "55" is written below the stamp.



Approved
Self

